

A preliminary amendment was submitted after mailing of the present Office Action but before Applicants' receipt thereof. Applicants assume that the requested amendment to cancel Claims 8-17 without prejudice was entered. If not, Applicants request that this amendment be entered at this time.

Remarks

Claims 1, 2 and 4-7 are under consideration in this case. A list of these claims is enclosed as an appendix for the Examiner's convenience.

As the only bar to allowance of the present claims, the Office Action states that the pending claims should be rejected under 35 U.S.C. § 102(a) over Saito et al., Mol. Cell. Neurosci. 6(3):280-92 (1995) (Saito) and under 35 U.S.C. § 102(f), each for similar reasons. Applicants respectfully traverse.

Applicants wish to thank Examiner Hayes for the interview on January 11, 2000 with Counsel Richard Trecartin. In the Interview, the Examiner stated that the only pending rejection at that time was under 35 U.S.C. § 102(f). The Examiner stated that the rejection would be maintained because Amy Greenwood and Qi Sun were named as "inventors" in the provisional application (Ser. No. 60/023,280) to which the present application claims priority, the provisional application being identical in disclosure to the above-cited paper. These co-authors of the Saito paper are not named as inventors for the present application. The Examiner stated that the In re Katz declaration submitted by Dr. Anderson was not sufficient to overcome the rejection. However, the Examiner suggested that declarations from Amy Greenwood and Qi Sun stating that they were not inventors of the claimed invention would be sufficient to overcome the rejection.

The Examiner's attention is directed to the accompanying declarations by Amy Greenwood and Qi Sun. It is clear from these declarations that, although both Amy Greenwood and Qi Sun contributed to the subject matter disclosed in the provisional application, they are not inventors of the claimed invention in the present utility application. Their contributions were technical, rather than inventive, and they worked under the direction of the inventors named in the present application.

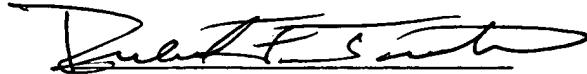
Applicants would like to state on the record that the submission of these declarations by Greenwood and Sun were not necessary to overcome the rejections. The rules for naming inventors for both provisional and utility applications are clearly spelled out in 37 C.F.R. § 1.45. The presently named inventors submitted an oath stating that they were the inventors of the present application. Dr. David Anderson submitted a declaration, in accordance with In re Katz, which states that the contribution of Greenwood and Sun did not rise to the level of inventorship for the present application, i.e., for the invention described in the presently pending claims. The declaration of Dr. Anderson not only did not contradict the provisional application, but the Examiner is required to take this declaration as truth (*see* MPEP § 605.07). The only evidence presented to contradict this declaration was the conclusion by the Examiner that since Greenwood and Sun were named as inventors in the provisional application, they must have been inventors for the presently claimed invention. This conclusion was clearly unfounded and inconsistent with PTO policy.

For the reasons stated above, Applicants respectfully request that the rejection of claims 1, 2 and 4-7 under 35 U.S.C. §§ 102(a) and (f) be withdrawn.

In light of the above remarks, Applicants submit that the present application is in condition for allowance and respectfully request early notification of such.

Respectfully Submitted,

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Dated: 2/14/00

APPENDIX--

1. (Amended) An isolated nucleic acid encoding a DRG11 protein, wherein said nucleic acid hybridizes under high stringency conditions to a complement of a nucleic acid molecule having a sequence as set forth in SEQ ID NO:1, and wherein said DRG11 protein is characterized by its natural expression in sensory neurons and dorsal horn neurons of the spinal cord and wherein its natural expression is absent in non-neuronal cells, sympathetic neurons and ventricular neurons of the spinal cord.
2. (Twice Amended) An isolated nucleic acid according to claim 1 encoding the amino acid sequence depicted in Figure 3 (SEQ ID NO:2).
4. (Twice Amended) An isolated nucleic acid according to claim 1 comprising the nucleic acid depicted in Figure 2 (SEQ ID NO:1).
5. (Amended) An isolated nucleic acid according to claim 1 operably linked to an expression vector comprising transcriptional and translational regulatory DNA.
6. A host cell transformed with an expression vector according to claim 5.
7. (Amended) A method of producing a DRG11 protein comprising:
 - a) culturing a host cell transformed with an expression vector comprising a nucleic acid according to claim 1; and
 - b) expressing said nucleic acid to produce a DRG11 protein.



PATENT

Attorney Docket No. A-63770-1/RFT/DAV/JJD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: R. Hayes
ANDERSON et al.)
Serial No. 08/701,278)
Filed: August 22, 1996)
For: A NOVEL HOMEODOMAIN)
PROTEIN)

)

DECLARATION UNDER 37 C.F.R. § 1.132

The Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

The undersigned, Qi Sun, hereby declares as follows:

1. I am the same Qi Sun who was identified as a co-inventor, as defined in 37 C.F.R. § 1.45(c), of Provisional Application Serial No. 60/023,280 with David J. Anderson, Tetsuichiro Saito, and Amy Greenwood.
2. I am also a co-author of "Identification by Differential RT-PCR of a Novel Paired Homeodomain Protein Specifically Expressed in Sensory Neurons and a Subset of Their CNS Targets", Saito, et al., *Molecular and Cellular Neuroscience*, (6) 280-292, (1995) (MCN publication), wherein my co-authors are Tetsuichiro Saito, Amy Greenwood and David J. Anderson, the disclosure of which is identical to the above-mentioned Provisional Application.

3. At the time of my contribution to the above-mentioned Provisional Application and MCN publication, I was a graduate student doing a three-month rotation in the laboratory of Dr David J. Anderson, under the direct supervision Dr. Tetsuichiro Saito.

4. My contribution to the Provisional Application and MCN publication consisted of isolating and sequencing the full-length cDNA clone encoding the DRG11 protein and performing *in situ* hybridization to localize the DRG11 expression pattern.

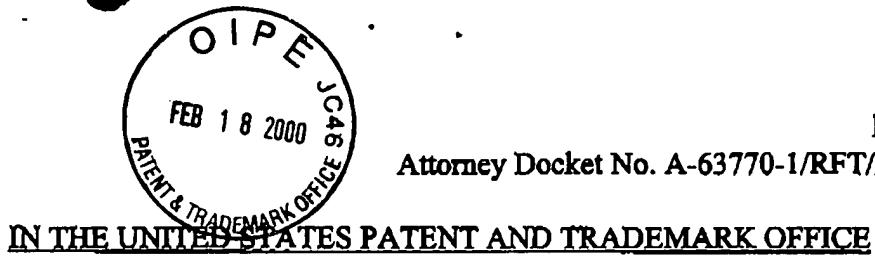
5. My contribution to the Provisional Application and MCN publication was strictly of a technical nature, using methods well known in the art.

6. I did not contribute to the conception of the invention disclosed and/or claimed in the above-cited utility application, nor to the ideas leading to the disclosure of the Provisional Application and MCN publication.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Date: 02/09/2000


Qi Sun



PATENT

Attorney Docket No. A-63770-1/RFT/DAV/JJD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: R. Hayes
)
ANDERSON et al.) Group Art Unit: 1645
)
Serial No. 08/701,278)
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Filed: August 22, 1996)
)
For: A NOVEL HOMEODOMAIN)
PROTEIN)
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DECLARATION UNDER 37 C.F.R. § 1.132

The Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

The undersigned, Amy Greenwood, hereby declares as follows:

1. I am the same Amy Greenwood who was identified as a co-inventor, as defined in 37 C.F.R. § 1.45(c), of Provisional Application Serial No. 60/023,280 with David J. Anderson, Tetsuichiro Saito, and Qi Sun.
2. I am also a co-author of "Identification by Differential RT-PCR of a Novel Paired Homeodomain Protein Specifically Expressed in Sensory Neurons and a Subset of Their CNS Targets", Saito, et al., *Molecular and Cellular Neuroscience*, (6) 280-292, (1995) (MCN publication), wherein my co-authors are Tetsuichiro Saito, Qi Sun and David J. Anderson, the disclosure of which is identical to the above-mentioned Provisional Application.



3. At the time of my contribution to the above-mentioned Provisional Application and *MCN* publication, I was working as a graduate student under the supervision of Dr.'s David J. Anderson and Tetsuichiro Saito.

4. My contribution to the Provisional Application and *MCN* publication consisted of making antibodies to the DRG-11 protein and producing two of the figures.

5. My contribution to the Provisional Application and *MCN* publication was strictly of a technical nature, using methods well known in the art.

6. I did not contribute to the conception of the invention disclosed and/or claimed in the above-cited utility application, nor to the ideas leading to the disclosure of the Provisional Application and *MCN* publication.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Date: Feb 8, 2000

A handwritten signature in black ink, appearing to read "Amy Greenwood".